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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/061,216

02/04/2002

Gregory P. Pogue

43276

3510

27860

7590

03/26/2007

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EXAMINER

HILL, MYRON G

ART UNIT

PAPER NUMBER

1648

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/061,216

**Applicant(s)**

POGUE ET AL.

**Examiner**

Myron G. Hill

**Art Unit**

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 79-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to the papers filed 9/22/06.

Claims 79-99 are under consideration.

#### ***Claim Objections Withdrawn***

Claim 95 was objected to because of the following informalities: "parenteral" appears to be misspelled.

Applicant has fixed the spelling and the objection is withdrawn.

#### ***Rejections Withdrawn***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 92-95 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has fixed the spelling and the rejection is withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 79-99 were rejected under 35 U.S.C. 103(a) being unpatentable over Garger *et al.* (US 6,033,895), (US 6,037,454), (US 6,303,779 B1) or (US 6,740,740 B2), each in the alternative, Koprowski *et al.* (US 6,042,832) and Francon *et al.* (US 5,075,110).

Applicant's arguments were persuasive and the rejection is withdrawn.

***New Rejection***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 77-99 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method to purify viral proteins with pH-Heat extraction using two extractions and two PEG precipitations, does not reasonably provide enablement for a method with one extraction and one PEG precipitation. The specification does not enable any person skilled in the art to which it pertains, or with

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which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant claims are evaluated for scope of enablement based on the Wands analysis. Many of the factors regarding undue experimentation have been summarized in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed.Circ.1988) as follows:

(1) the nature of the invention, (2) the state of the prior art, (3) the predictability or lack thereof in the art, (4) the amount of direction or guidance present, (5) the presence or absence of working examples, (6) the quantity of experimentation necessary, (7) the relative skill of those in the art, and (8) the breadth of the claims.

The invention is drawn to a method to method to purify viral proteins with pH-Heat extraction using two extractions and two PEG precipitations and the claims encompass only one extraction and one PEG precipitation.

The prior art teaches extraction of viral proteins from green juice similar to the claims, see Garger *et al.* (US 6,033,895) claims 1-3 and 10-11.

The prior art teaches yields of about 0.2 mg/g fresh weight Garger *et al.* (US 6,033,895) Tables 1 and 2.

Specification provides guidance and direction to purify viral proteins with pH-Heat extraction using two extractions and two PEG precipitations (example 6A).

The specification teaches that the results depend on the plant strain used and the virus preparation method (Table 1 and commentary below it (Page 19).

The claims do not reflect this difference.

There is no evidence or guidance or directions how to purify the viral proteins without the extra extraction or PEG precipitation and obtain the same results.

The enabling disclosure is clearly not commensurate in scope with these claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Without specific guidance or direction and /or working examples, one of ordinary skill in the art would not be able to reproducibly practice the method as claimed, without undue experimentation.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myron G. Hill whose telephone number is 571-272-0901. The examiner can normally be reached on 8:30 am-5 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Myron G. Hill  
Patent Examiner  
3/16/06



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